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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,292	01/25/2002	Alfred Trzmiel	P6588.3US	1990
30008	7590	11/02/2005	EXAMINER	
GUDRUN E. HUCKETT DRAUDT			KEASEL, ERIC S	
LONSSTR. 53				
WUPPERTAL, 42289			ART UNIT	
GERMANY			PAPER NUMBER	
			3754	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/057,292	Applicant(s) TRZMIEL ET AL.	
	Examiner Eric Keasel	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.  
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2,3,5 and 7-51 is/are pending in the application.  
 4a) Of the above claim(s) 2,3 and 10-47 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 4,7-9 and 48-51 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 20 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All b) ☐ Some \* c) ☐ None of:  
 1. ☒ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group IV, Species B in the paper filed January 16, 2004 is acknowledged.
2. Claims 2, 3, and 10-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups and/or Species, there being no allowable generic or linking claim. Election was made **without** traverse in the paper filed January 16, 2004.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 5, 7-9, and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman (US Patent Number 4,866,091) in view of Weber (US Patent Number 5,911,245).

Coleman discloses a control device for hydraulic, mechanical, and hydraulic-mechanical components comprising a housing (see the embodiment of Figs. 4 and 5); at least one drive element (98, 114) arranged in the housing; further comprising a piston (92) arranged in the housing, wherein the drive element (98, 114) indirectly controls the piston (92); further comprising single pressure springs (100, 116) on either side of the piston and arranged in the housing, wherein the drive element (98, 114) engages the piston (92) with interposition of the at least one pressure spring (100, 116); wherein two of the drive elements (98, 114) are provided, wherein the two drive elements (98, 114) act indirectly on opposed ends of the piston (92); wherein the piston (92) is configured to be centered by a spring force in a center position when the two drive elements (98, 114) are not excited (see Fig. 4); wherein the drive element (98, 114) is a part of a directional control valve; wherein the directional control valve is directly controlled or pilot-operated; and the springs (100, 116) each rest against piston members (102, 118).

Coleman discloses the drive actuator as two solenoids on either side of the spool piston member rather than PE elements. Weber discloses that when the dynamic forces on the piston spool are generally equal and cancel each other out (as in the case of Coleman, Figs. 4 and 5), that PE device is an equivalent actuator to a solenoid actuator. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have replace the solenoids of Coleman with PE devices because one of ordinary skill in the art would have expected applicant's invention to perform equally well with PE devices or solenoids because Weber discloses that they are equivalent actuators when the dynamic forces on

the piston spool are generally equal and cancel each other out. Therefore, it would have been an obvious matter of design choice to modify Coleman to obtain the invention as specified in claims 5, 7-9, and 48-51.

### *Response to Arguments*

5. Applicant's arguments filed August 11, 2005 have been fully considered but they are not persuasive.

Coleman discloses a single pressure spring on either side of the piston. The rejection remains proper because applicant has used the transitional phrase "comprising", which allows for additional elements, such as the dashpots (106, 120) in the Coleman reference. Even if applicant amended the claims to require only one spring on either side of the piston (which arguably would be new matter), the omission of an element (the dashpot which includes a spring) along with its function is obvious (see MPEP 2144.04(II)(A)).

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (571) 272-4929. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 28 OCT 2005  
Eric Keasel  
Primary Examiner  
Art Unit 3754